

REMARKS

Claims 1-72 are pending in the present application. In the office action mailed January 10, 2003 ("the Office Action"), claims 1-72 were rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. Claims 11 and 16 were objected to because the changes made to the claims in the certificate of correction of the parent application must be included in the claims without underlining or bracketing. Claims 58 and 61-72 were rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claims 53-72 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. Claims 58, 59, and 61-72 were rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 58 and 61-72 were further rejected under 35 U.S.C. 251 as not being the same invention as that disclosed as being the invention in the original patent. Claims 58, 63, and 64 were rejected under 35 U.S.C. 102(a) as being anticipated by applicants' admitted prior art ("the APA"). Claims 61, 62, 67, 68, 71, and 72 were rejected under 35 U.S.C. 103(a) as being unpatentable over the APA.

With respect to the defective reissue declaration, and the rejection of claims 1-72 as being based upon a defective reissue declaration, applicants request that these rejections be held in abeyance until agreement of allowable subject matter, at which time, applicants will submit a proper declaration as set forth by 37 C.F.R. 1.175.

With respect to the objection to claims 11 and 16, a clean copy of the specification of the present reissue application is provided herewith including the changes made to claims 11 and 16 in the certificate of correction of the parent application without underlining or bracketing.

With respect to the original patent, applicants submitted the original letters Patent No. 6,026,496 with the Patent Office on October 30, 2002. A copy of the previously filed transmittal is attached, along with a copy of the stamped return receipt postcard, indicating that the original patent was received by the Patent Office on November 5, 2002.

With respect to the rejection of claims 58 and 61-72 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, the applicants disagree with the Examiner's rejection. As argued by the Examiner, "[e]lements critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. . . . The specification describes the use of a pass gate to perform the steps of transferring and blocking the trigger signal from an input node to an output node, coupling and decoupling/deactivating the input node to the output node No other methods of performing the above steps are described in the specification. In addition, applicant has distinguished the invention over the described prior art method by using a pass gate rather than the logic gate in the circuit of figure 1." See Office Action, paragraph 7. The Examiner reasons from this that "[t]he pass gate is clearly a critical or essential element that is required to perform the above steps as described in connection to Figures 1 and 3."

Examiner's position is wholly incorrect. Nowhere in the specification does it state, or even imply, that having a pass gate is critical for the invention. The Examiner has mischaracterized the language of the specification, as well as the rule of law, in order to substantiate a baseless rejection under 35 U.S.C. 112, first paragraph.

As previously mentioned, the Examiner argues that "[n]o other methods of performing the above steps are described in the specification," and consequently, "[t]he pass gate is clearly a critical or essential element." The Office Action, paragraph 7. This, however, is the incorrect inquiry in determining whether a critical feature is not claimed. As stated by MPEP 2164.08(c), "an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made *only* when the language of the specification makes it clear that the limitation is critical for the invention of function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality." Such "broad language" is provided in the current specification. For example, at col. 8, lines 63-65, it expressly states that "the above disclosure is illustrative only, and changes may be made in detail, and yet remain within the broad principles of the invention." Moreover, in the claims, which is a part of the disclosure, claim 14 recites a one-shot circuit for generating a pulse that does include a pass gate. Clearly, the "invention" does not require a pass gate to be included.

Additionally, even if we look at the material cited by the Examiner, namely Figure 3, col. 4, lines 25-40, and col. 6, lines 29-39, it is difficult to understand how the Examiner comes to the conclusion that the description of Figure 3 limits the invention to having a pass gate, and consequently, a pass gate is a critical or essential element that is required for the invention. Nowhere in the specification does it state that Figure 3 defines the scope of the invention. On the contrary, it states in several places that Figure 3 and the description thereof is directed to a particular *embodiment* of the present invention. That is, Figure 3 is not *the* invention, but merely an *embodiment* of the invention. For example, at col. 4, lines 12-14, Figure 3 is describes as a schematic diagram of a signal generation circuit according to *one embodiment* of present invention. Also, at col. 4, lines 25-27, the first sentence clearly states that schematic diagram of Figure 3 merely illustrates “*one embodiment* of a signal generating circuit.” (Emphasis added.) At col. 6, lines 29-39, again it is stated that “*the embodiment* of the invention shown in FIG. 3 saves two logic propagation delay times because it uses the passgate 120.” (Emphasis added.) Clearly, the material cited by the Examiner clarifies that Figure 3 and the related description is not the invention itself, but an example of the present invention. As expressly stated in MPEP 2164.08(c), “[f]eatures which are merely preferred are not to be considered critical.”

For the foregoing reasons, the rejection of claims 58 and 61-72 under 35 U.S.C. 112, first paragraph, should be withdrawn.

With respect to the rejection of claims 58, 59, and 61-72 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based, Applicants also disagree with the Examiner’s rejection. The Examiner argues that claims 58, 59, and 61-72 attempt to recapture subject matter that was surrendered in the parent application “because applicant did not comment on the examiner’s reasons for allowance and have acquiesced to the reasons. See MPEP 1302.14.” See the Office Action at paragraph 9.

The Examiner has overlooked the fact that at the time the issue fee was paid for the parent, namely, November 23, 1999, the rules regarding applicant’s comments on the examiner’s statement of reasons for allowance, 37 C.F.R. 1.104(e), as well as MPEP 1302.14, were different. Section 1.104(e) at the relevant time provides that “The applicant or patent

owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement *does not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.*" (Emphasis added.) With respect to MPEP 1302.14, the correct version of this section is provided in the seventh edition, which is silent on the matter of any presumption of acquiescence for failure of an applicant to comment on reasons for allowance. Thus, at the time the applicant could have submitted comments on the reasons for allowance, that is, November 23, 1999, failure to do so did not have the consequences which are present under the current rules and the current version of MPEP 1302.14. Consequently, the applicants are not now attempting to recapture subject matter that was surrendered in the parent application because applicants did not surrender subject matter in the parent application by acquiescing to the reasons for allowance provided at that time by the examiner.

For the foregoing reasons, the rejection of claims 58, 59, and 61-72 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the parent application should be withdrawn.

With respect to the rejection of claims 58 and 61-72 under 35 U.S.C. 251 as not being the same invention as that disclosed as being the invention in the original patent, the Applicants again disagree with the Examiner's argument. It appears that the Examiner is under the impression that "[n]o other methods of performing the [steps of the claims 58 and 61-72] are described in the specification," and that the applicant has limited the scope of the invention by describing advantages of one embodiment of the present invention, and as a result, any claims not having a pass gate would be a different invention from the one disclosed in the parent application.

The Examiner's inquiry is not relevant to determining whether the reissue claims are for the same invention as the original patent. As provided in MPEP 1412.01,

Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

As previously discussed with the rejection of claims 58 and 61-72 under 35 U.S.C. 112, first paragraph, the scope of the invention is not limited to that illustrated in Figure 3 because Figure 3 and the related description is directed to *an embodiment* of the present invention. Additionally, the description provided by the specification does enable claims 58 and 61-72, that is, the specification teaches those ordinarily skilled in the art how to make and use the claimed invention without undue experimentation. The specification includes the embodiment of Figure 3, which is capable of performing the methods of generating a pulse responsive to a trigger signal transitioning from a first state to a second state, as claimed in claims 58, 61, and 62, and the methods for generating a pulse responsive to a trigger signal applied to an input node transitioning from a first state to a second state, as claimed in claims 63-67. However, the particular embodiment, although enabling the claimed inventions, does not serve to limit the scope of the invention. Additionally, the specification is void of any language indicating any intent not to claim the subject matter of the claims presented in the reissue application. On the contrary, the specification expressly states that “the above disclosure is illustrative only, and changes may be made in detail, and yet remain within the broad principles of the invention.” See col. 8, lines 63-65.

For the foregoing reasons, the rejection of claims 58 and 61-72 under 35 U.S.C. 251 should be withdrawn.

With respect to the rejection of claims 58, 63, and 64 under 35 U.S.C. 102(a) as being anticipated by the APA, the Applicants again disagree with the Examiner’s rejection. The APA fails to teach the combination of limitations as recited by claims 58, 63, or 64. For example, claim 58 recites a method for generating a pulse responsive to a trigger signal transitioning from a first state to a second state, the method comprising transferring the trigger signal from an input node to an output node, propagating the trigger signal through a delay circuit, and in response to the trigger signal propagating through the delay circuit, blocking the trigger signal from the input node to the output node and discharging the output node. The APA does not teach at least the aspect of blocking recited in claim 58. As seen in Figure 1, the CLK signal is propagated through the entire chain of gates, beginning with the NAND gate 40, through the delay circuit 52 and inverters 54, 56, and 58, to be output as the IOPU signal. Unlike

the prior art shown in Figure 1, the invention of claim 58 decouples the input and output of the passgate 120, thereby blocking the propagation of the CLK signal.

Claim 63 recites a method for generating a pulse responsive to a trigger signal applied to an input node transitioning from a first state to a second state, the method comprising coupling the input node to an output node at which the pulse is provided for a period of time in response to the transition of the trigger signal from the first state to the second state, decoupling the input node from the output node after the period of time has elapsed, and discharging the output node to a voltage level representative of the first state in response to the period of time elapsing. In contrast, the output node of the conventional signal generation circuit of Figure 1, as defined by the Examiner, does not decouple the input node from the output node after the period of time has elapsed, and discharge the output node to a voltage level representative of the first state in response to the period of time elapsing, as recited in claim 63. As previously discussed, the CLK signal is merely propagated through the chain of gates to be output as the IOPU signal. Therefore, as with claim 58, the APA does not recite the combination of limitations as recited by claim 63, and consequently, does not anticipate claim 63.

For the foregoing reasons, claims 58 and 63 are patentably distinct over the APA. Similarly, claim 64, which depends from claim 63, is also patentably distinct over the APA because of its dependency from allowable base claim 63. Therefore, the rejection of claims 58, 63, and 64 under 35 U.S.C. 102(a) should be withdrawn.

With respect to the rejection of claims 61, 62, 67, 68, 71, and 72 under 35 U.S.C. 103(a) as being unpatentable over the APA, the applicants disagree. Claims 61 and 62, which depend from claim 58, and claim 67, which depends from claim 63, are patentable based on their dependency from respective allowable base claims.

Claim 68 is patentable over teachings of the APA because the combined teachings of the APA, and what the Examiner characterizes as “would have been obvious for one of ordinary skill in the art,” *see* the Office Action at paragraph 15, pp. 9 and 10, does not teach or suggest the combination of limitations recited by claim 68. Claim 68 recites a method for generating a pulse responsive to a trigger signal applied to an input node transitioning from a first state to a second state, the method comprising coupling an input node at which the trigger signal is applied to an output node at which the pulse is provided through a transfer gate,

generating a deactivation signal from the trigger signal delayed by a delay time to deactivate the transfer gate, deactivating the transfer gate in response to the generation of the deactivation signal to decouple the input node from the output node, and coupling the output node to ground in response to the generation of the deactivation signal to change the voltage level of the output node to a voltage representative of the second state.

The combined teachings of the APA and obvious knowledge in the art fail to teach or suggest at least the aspects of deactivating the transfer gate in response to the generation of the deactivation signal to decouple the input node from the output node, and coupling the output node to ground in response to the generation of the deactivation signal to change the voltage level of the output node to a voltage representative of the second state, as recited by claim 68. Therefore, claim 68 is patentable over the combined teachings of the APA and obvious knowledge in the art.

Claims 71 and 72, which depend from claim 68, are also patentable over the APA and the obvious knowledge in the art based on the dependency from allowable claim 68.

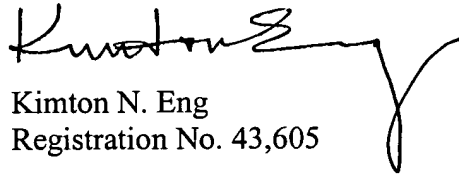
For the foregoing reasons, the rejection of claims 61, 62, 67, 68, 71, and 72 under 35 U.S.C. 103(a) should be withdrawn.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **“Version with Markings to Show Changes Made”**.

All of the claims pending in the application are in condition for allowance. Favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is requested to contact the undersigned at the number listed below for a telephone interview if, upon consideration of this amendment, the Examiner determines any pending claims are not in condition for allowance. The undersigned also requests the Examiner to direct all future correspondence to the address set forth below in the event the Examiner shows a different correspondence address for the attorney of record.

Respectfully submitted,

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Enclosures:

- Postcard
- Fee Transmittal Sheet (+ copy)
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 63 and 68 have been amended as follows:

63. (Once amended) A method for generating a pulse responsive to a trigger signal applied to an input node transitioning from a first state to a second state, the method comprising:

coupling the input node to an output node at which the pulse is provided for a period of time in response to the transition of the trigger signal from the first state to the second state;

decoupling the input node from the output node after the period of time has elapsed; and

discharging the output node to a voltage level representative of the first state in response to the period of time elapsing.

68. (Once amended) A method for generating a pulse responsive to a trigger signal applied to an input node transitioning from a first state to a second state, the method comprising:

coupling an input node at which the trigger signal is applied to an output node at which the pulse is provided through a transfer gate;

generating a deactivation signal from the trigger signal delayed by a delay time to deactivate the transfer gate;

deactivating the transfer gate in response to the generation of the deactivation signal to decouple the input node from the output node; and

coupling the output node to ground in response to the generation of the deactivation signal to change the voltage level of the output node to a voltage representative of the second state.